

REMARKS

The Office Action rejects Claims 1-9, 11-19, 20-28, 31-39, and 43-49 under 35 U.S.C. § 101 (statutory type double patenting) as being unpatentable over Claims 5-13 of U.S. Pat. No. 6,608,274 ("the '274 Patent"). Applicant respectfully traverses this rejection because for a statutory double patenting rejection to be proper, identical subject matter must be claimed. *See Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). The MPEP confirms that if there is an embodiment that falls within the scope of one claim and not in the other, "then identical subject matter is not defined by both claims and statutory double patenting does not exist." MPEP § 804.

For example, the Office Action rejects Claim 1 of the present Application (along with Claims 11, 20, 31, and 41) in view of Claim 5 of the '274 Patent. Independent Claim 1 of the '274 Patent recites:

A system for handling checks, comprising:
a sorter operable to retrieve MICR data from a plurality of checks;
an emulator coupled to the sorter, the emulator operable to access the MICR data and to generate a process buffer based on the MICR data;
a communication engine coupled between the emulator and a check processing system, the communication engine operable to communicate between the emulator and the check processing system in real-time, the check processing system operable to receive the process buffer from the emulator through the communication engine and to generate a plurality of feature instructions for each check based on the process buffer; and
the emulator further operable to communicate the feature instructions to the sorter, the sorter further operable to process the checks based on the feature instructions.

Claim 5 of the '274 Patent, depending on Claim 1, recites:

The system of claim 1, the process buffer standardized for a plurality of disparate types of check sorters.

and independent Claim 1 of the present application recites:

A method for communicating between a check processing system and a non-compatible check sorter, comprising:
accessing MICR buffer data for the check sorter, the MICR buffer data comprising MICR data retrieved from a check;

generating process buffer data based on the MICR buffer data, the process buffer data standardized for a plurality of disparate types of check sorters;
receiving a plurality of feature instructions for the check based on the process buffer data; and
communicating the feature instructions to the check sorter for processing of the check.

Claim 1 of the '274 Patent includes "the check processing system operable ... to generate a plurality of feature instructions for each check based on the process buffer," which is clearly missing from Claim 1 (as well as Claims 11, 31, and 41) of the present application. Indeed, Claim 20 of the present Application recites "the emulator operable ... to generate a plurality of feature instructions for each check based on the process buffer data," *in direct contrast to* Claim 1 of the '274 Patent reciting "the check processing system operable to ... generate a plurality of feature instructions for each check based on the process buffer." Applicants respectfully assert that Claim 1 (as well as Claims 11, 20, 31, and 41) of the present Application is distinct from Claim 1, and dependent Claim 5, of the '274 Patent and, therefore, there is an embodiment that falls within the scope of one claim and not in the other. *See* MPEP § 804. Put another way, Claims 1, 11, 20, 31, and 41 of the present application do not claim identical subject matter as Claim 5 of the '274 Patent as required for a proper statutory double patenting rejection. *See In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

In another example, the Office Action rejects Claims 2, 21, and 32 of the present Application in view of Claim 6 of the '274 Patent. Claim 6 of the '274 Patent, depending from Claim 1 above, recites:

The system of claim 1, the standardized process buffer comprising a format compatible with the check processing system.

and dependent Claim 2 of the present application recites:

The method of Claim 1, the standardized process buffer data comprising a format compatible with a check sorter compatible with the check processing system.

Applicant notes that Claim 6 of the '274 Patent does not depend from Claim 5, which the Office Action asserts is in conflict with Claim 1 of the present Application. Put another way, Claim 6 of the '274 Patent is missing "the process buffer standardized for a plurality of disparate types of

check sorters” of Claim 5, which the Office Action asserts is included in Claim 1 of the present Application, from which Claim 2 depends. For at least this reason, there is clearly an embodiment that falls within the scope of one claim and not in the other. *See* MPEP § 804.

Accordingly, Applicant respectfully asserts that statutory double patenting does not exist between the present claims and the claims of the ‘274 patent and the rejection is improper. Applicant respectfully requests that the double patenting rejection of Claims 1-27 be withdrawn.

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CONCLUSION

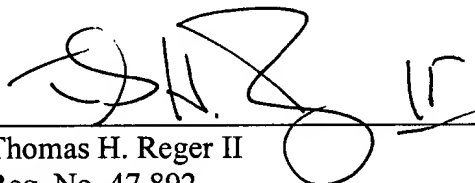
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims. If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Please note that the **Attorney's Docket number** is **17730-006001** as indicated on the Revocation and New Power of Attorney filed on June 3, 2004.

Applicant believes no fees to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to deposit account 06-1050.

Respectfully submitted,

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